



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,731	09/29/2006	Kazuya Matsumoto	1034232-000045	9491
21839 7590 12/03/2007 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER WITHERSPOON, SIKARL A	
			ART UNIT 1621	PAPER NUMBER
			NOTIFICATION DATE 12/03/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com  
debra.hawkins@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/594,731	<b>Applicant(s)</b> MATSUMOTO ET AL.	
	<b>Examiner</b> Sikarl A. Witherspoon	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/29/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-5 and 8-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a process for producing a hydroxyaldehyde using a D-2-deoxyribose-5-phosphate aldolase (DERA) having a DNA sequence of SEQ ID NO : 1 or an amino acid sequence of SEQ ID NO : 2, does not reasonably provide enablement for any and all variants and/or mutants thereof, or for any and all fragments that may contain these sequences (claim 2 (2) recites "an" amino acid sequence, which reads on fragments). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the process of the invention commensurate in scope with these claims.

The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. See *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue" include, but are not limited to: (1) the breadth of the claims; (2) the nature of the invention; (3) the state of the prior art; (4) the level of one of ordinary skill; (5) the level

of predictability in the art; (6) the amount of direction provided by the inventor; (7) the existence of working examples; and (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure.

Despite knowledge in the art for producing muteins of a given polypeptide with amino acid deletions, insertions or substitutions the specification fails to provide any guidance regarding the changes/modifications contemplated and yet retain the function(s) of the DERA employed in the claimed process. Furthermore, detailed information regarding the structural and functional requirements of the disclosed mutein protein is lacking. Although it is accepted that the amino acid sequence of a polypeptide determines its structural and functional properties, predicting a protein's structure and function from mere sequence data remains an elusive task. The problem of predicting protein structure from sequence data and in turn utilizing predicted structural determinations to ascertain functional aspects of the protein is extremely complex. While it is known that many amino acid substitutions are generally possible in any given protein the positions within the protein's sequence where such amino acid substitutions can be made with a reasonable expectation of success are limited. Certain positions in the sequence are critical to the protein's structure/function relationship, e.g. such as various sites or regions directly involved in binding, activity and in providing the correct three-dimensional spatial orientation of binding and active sites. These regions can tolerate only relatively conservative substitutions or no substitutions (see Wells, 1990, *Biochemistry* 29:8509-8517; Ngo et al., 1994, *The Protein Folding Problem and Tertiary Structure Prediction*, pp. 492-495). However, Applicant has provided little or no

guidance beyond the mere presentation of sequence data to enable one of ordinary skill in the art to determine, without undue experimentation, the positions in the protein which are tolerant to change (e.g. such as by amino acid substitutions or deletions), and the nature and extent of changes that can be made in these positions. Even if an active or binding site were identified in the specification, they may not be sufficient, as the ordinary artisan would immediately recognize that an active or binding site must assume the proper three-dimensional configuration to be active, which conformation is dependent upon surrounding residues; therefore substitution of non-essential residues can often destroy activity. The instant disclosure fails to disclose which if any functions of the DERA activities will remain after the mutation of the polypeptide. It is also unclear what, if any functions will be enhanced. Therefore, predicting which variants would retain the functions of the protein is well outside the realm of routine experimentation. Thus, undue amount of experimentation would be required to generate changes/modifications contemplated and yet retain the function of the DERA employed in the claimed aldol condensation process.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-5 and 8-11 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2, feature (2) recites an "amino acid" sequence of SEQ ID NO :1; however, according to the sequence listing submitted by applicants, SEQ ID NO : 1 is a DNA sequence.

Claim 9 is further rejected has being indefinite because it recites the compound of formula (7) as an aldehyde; however, the compound of formula (7) is not an aldehyde.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong et al (US 5,795,749).

The claims are drawn to a method of producing a hydroxaldehyde by conducting an aldol condensation of an aliphatic aldehyde with acetaldehyde using D-2-deoxyribose-5-phosphate aldolase (DERA) to catalyze the reaction.

Wong et al teach an adol condensation reaction between chloroacetaldehyde and acetaldehyde using DERA (col. 5, line 20 to col. , line 10, and see example 7).

The differences between Wong et al and the instant claims are that Wong et al do not expressly teach that the DERA has a property of retaining at least 50 % activity

after treating at 25° C for 30 minutes, and does not teach SEQ ID NO 1 and 2, as recited in the instant claims.

Regarding the first difference, the examiner takes the position that while silent in this regard, the DERA employed by Wong et al retains at least 50 % activity after treating at 25° C for 30 minutes, since the reactions taught by Wong et al last for over 24 hours according to the examples. It would therefore be obvious to a person having ordinary skill in the art that the DERA retains at least desirable catalytic activity after treating for 30 minutes.

Regarding the second difference, Wong et al is silent with respect to the amino acid sequence of the DERA employed therein. However, since the DERA employed by the reference has the same function as that corresponding to DERA having DNA sequence SEQ ID NO :1 and amino acid sequence SEQ ID NO :2, and since the instant claims (claim 2, (2)) reads on any amino acid sequence comprising SEQ ID NO :2 (NO :1 is a DNA sequence), the examiner contends that it would have been obvious to a person having ordinary skill in the art the DERA employed in the process of Wong et al contains the same amino acid sequence as the DERA described in the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sikarl A. Witherspoon whose telephone number is 571-272-0649. The examiner can normally be reached on M-F 8:30-6:30.


Application/Control Number:  
10/594,731  
Art Unit: 1621

Page 7

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

saw

  
SIKARL A. WITHERSPOON  
PRIMARY EXAMINER